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EXAMINER

TURK, NEIL N

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

DETAILED ACTION

Remarks

This Office Action fully acknowledges Applicant's remarks filed on January 10th, 2008. Claims 9-15 are pending. Claims 9-15 have been newly added. Claims 1-8 have been cancelled. Any objection/rejection not repeated herein has been withdrawn by the Office.

Claim Interpretation

Examiner asserts that Applicant has set forth Jepson-type claims in the newly added claims 9-15. As such, the preamble of claim 9 is said to be admitted prior art and the claims/recitations that are to be examined on the merits are thereby drawn to the body of the claim, which is drawn to piercing tool attachment/detachment elements (apparatus), noted by the preceding improvement clause in the claims.

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The specification does not provide proper antecedent basis for the "means for attaching" and "means for releasing" limitations recited in the claims.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 9-15 are rejected under 35 U.S.C. 112, second paragraph as being unclear and indefinite to what structure Applicant is intending to encompass with the “means for attaching” and “means for releasing” limitations. Claims 9-15 recite “means for attaching” and “means for releasing”. The Examiner has interpreted this limitation as a means-plus-function limitation covered by 35 USC 112, sixth paragraph. This interpretation is proper since the claim limitation recites “means for” language, and the “means for” is not modified by sufficient structure for achieving the specified function. A means-plus-function limitation recites a function to be performed rather than definite structure or materials for performing that function. For claims falling under 35 USC 112, sixth paragraph, Examiners are required to construe claims as covering the corresponding structure, material, or acts described in the specification and equivalents thereof, see *In re Donaldson Co.*, 29 USPQ2d 1845 (Fed. Cir. 1994). However, the specification does not set forth the corresponding structure. Thus, it is unclear and indefinite what structure Applicant is intending to encompass with the “means for attaching” and “means for releasing” limitations. There is no antecedent basis in the specification for such “means for” language.

Clarification is required.

Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 12 recites a process limitation to how the slidable guide is biased, and does not recite further structural elements for establishing such a bias. As the claims are drawn to an apparatus, such a process limitation is not afforded patentable weight.

Claim 13 recites the limitation "said lever". There is insufficient antecedent basis for this limitation in the claim.

Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 13 recites that the means for releasing the piercing tool comprises an opening in a wall of the container. As claim 9 recites that the container is for holding the piercing tool, it is unclear how the same container is capable of releasing the piercing tool. Is there another container for such releasing? Does the container of claim 9 have additional capabilities to that currently recited in claim 13?

Claims 14 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear what further structural limitations are established with respect to the improvement recited in claim 9. Claims 14 and 15

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are drawn to functional limitations with respect to the action of the piercing tool toward a pierceable seal of a reagent bottle. As the claims are drawn to the improvement of a piercing tool attachment/detachment elements (an apparatus), the functional and process limitations of claims 14 and 15 are not afforded patentable weight. This is further seen as claim 15, in addition to being dependent upon claim 14, recites a process limitation to how the slidable guide is biased, and does not recite further structural elements for establishing such a bias.

Further, with regard to claim 14, the claim will be taken to read that the piercing tool has a slidable guide mounted around a lower end thereof. This is seen as the further limiting recitation to independent claim 9, as the remainder of the claim is drawn to the reagent bottle's seal, which is not a limitation to Applicant's invention (the piercing tool attachment/detachment elements), and further limitations which are drawn to functional and process limitations.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 9 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Long (5,200,151).

Long discloses a fluid dispensing system having a pipette assembly with a preset tip locator (abstract). Long discloses a table 68 (container for seal piercing tool) which holds pipette tips 70 (seal piercing tool) that are to be affixed to the stem 72 (nozzle) of the pipette 40. Long discloses a vertical drive 78 of an X-Y-Z transport mechanism 64 with the pipettes, where the vertical drive 78 (means for attaching the piercing tool to the nozzle) allows the pipette to be driven down to affix the pipette tip to the stem (lines 41-67, col. 4, figs. 1&2). Long further discloses that the transport is operative in the process of affixing a tip 70 to the stem 72 of a pipette 40 and in the detachment of the tip from the stem. Long discloses an extractor 116 for removing the pipette tip 70 and depositing the tips into bin 120 (lines 14-67, col. 6, fig. 2).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Long in view of Mawhirt (5,137,693).

Long has been discussed above.

Long does not disclose that the piercing tools are held in place by a leaf spring.

Mawhirt discloses a spring biased test tube holder. Mawhirt discloses a test tube holder in which leaf springs 140, 142 act to securely holding the test tube (as well as releasing the test tube when proper action/force is applied) within the holder (lines 32-67, col. 4, col. 6, 8, and 9, figs. 8-10).

It would have been obvious to modify Long to include leaf springs within the container such as taught by Mawhirt in order to provide structure for securely holding the pipette tips within the container until action/force is applied for their removal and attachment to the stem of the pipette.

Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Long in view of Lopez et al. (4,752,292), hereafter Lopez.

Long has been discussed above.

Long does not disclose that the piercing tool has a lever mounted on the piercing tool, and does not disclose that the nozzle has a slot formed therein, where the lever is spring-biased to a closed position.

Lopez discloses a medical connector in which a piercing tool 92 (the cap is capable of piercing) has a latch locking mechanism 90, with a spring 130 for biasing the lever to a closed position with respect to the nozzle 91, where it engages slots 102 and 103a (port 91 and its structure act as a nozzle) (lines 9-32, col. 8; line 51, col. 9 - line 15, col. 10; figs. 7-10a).

It would have been obvious to modify Long to include a lever mounted on the piercing tool and slots formed within the nozzle for receiving the lever, and further including a spring biased to a closed position such as taught by Lopez in order to provide structure to the piercing tool that would allow for reliably and releasably securing the piercing tool to the nozzle.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Long.

Long has been discussed above.

If the container described in claim 13 is taken to be the same container as that which holds the seal piercing tool, it would have been obvious to modify Long. Long discloses a container 68 for holding the pipette tips (seal piercing tools) and a container 120 having an opening 116 in a wall for releasing the pipette tip.

It would have been obvious to combine the container 68 and container 120 into a single unit as such a modification would provide for a more compact device, saving space, and the transport mechanism would still be able to reach either container depending upon the operation.

Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Long in view of Homberg et al. (5,792,424), hereafter Homberg.

Long has been discussed above.

Long does not disclose that the piercing tool has a slidable guide mounted around a lower end thereof, and does not disclose that the slidable guide is biased downwardly by a spring.

Homberg discloses a slidable guide 60 at the lower end that is urged toward downward to stop 46 by a spacing spring 70 (lines 10-49, col. 15, fig. 11).

It would have been obvious to modify Long to include a slidable guide that is biased downwardly by a spring such as taught by Homberg in order to provide an adjustable guide for selectively exerting a force to apply the piercing tool to the intended position.

Response to Arguments

Applicant's arguments with respect to claims 1-8 have been considered but are moot as the claims have been cancelled. New ground(s) of rejection have been discussed above with respect to newly added claims 9-15.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NEIL TURK whose telephone number is (571)272-8914. The examiner can normally be reached on M-F, 9-630.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

NT

/Jill Warden/
Supervisory Patent Examiner, Art Unit 1797